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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,916	06/27/2003	Yoshiaki Nishiya	223380	8116

23460 7590 08/06/2009
LEYDIG VOIT & MAYER, LTD
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EXAMINER

DO, PENSEE T

ART UNIT	PAPER NUMBER
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1641

NOTIFICATION DATE	DELIVERY MODE
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08/06/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Chgpatent@leydig.com
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Office Action Summary	Application No.	Applicant(s)	
	10/607,916	NISHIYA ET AL.	
	Examiner	Art Unit	
	Pensee T. Do	1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,8 and 15-24 is/are pending in the application.
 4a) Of the above claim(s) 15-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,6, 8, 15-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Priority

This application, 10607916, PG Pub. No. 20040126902, filed 06/27/2003 claims foreign priority to 188140/2002, filed 06/27/2002, and also claims foreign priority to 230533/2002, filed 08/07/2002 and claims foreign priority to 267170/2002, filed 09/12/2002.

Amendment Entry & Claims Status

The amendment filed on April 24, 2009 has been acknowledged and entered.

Claims 1, 6, 8, 15-24 are pending.

Claims 1, 6, 8 are being examined.

Claims 15-24 are withdrawn from further consideration due to a non-elected invention.

Claimed Invention

1. (Currently Amended) A magnetic carrier for a biological substance, which
 - (i) has a saturation magnetization of ~~10-80 A·m²/kg~~ 30-80 A·m²/kg and a coercive force of 2.39-11.94 kA/m,
 - (ii) is a ferromagnetic iron oxide particle coated with silica comprising (a) a ferromagnetic iron oxide particle having an aspect ratio of 1.0-1.2 and (b) silica coating the particle in a proportion of 3-100 wt% of the particle, wherein the particle has an average particle size of 0.1-0.5 μm , and
 - (iii) can bind a nucleic acid.

Maintained Rejection(s)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Takiguchi et al. (US 5,137,796).

Takiguchi teaches magnetic particle which has a saturation magnetization of 60-90 emu/g or A.m²/kg and a coercive force of 40-80 Oe which falls within the range of 2.39 (30 Oe) - 11.94 KA/m; (see col. 13, lines 44-59); and is a ferromagnetic iron oxide particle (see col. 14, lines 13-16) coated with silica in a proportion of 3-100 wt% of the particle (see col. 5, lines 60—5) and has a particle size of 5 micron or less. (see col. 6, lines 52-54). Regarding the limitation of the particle can bind a nucleic acid. Since the particle of Takiguchi has the same characteristics as that of the present invention, it would be able to bind a nucleic acid.

With respect to claim 6 and 8, Takiguchi teaches the magnetic carrier is a magnetite particle (see col. 14, lines 12-16).

Response to Arguments

Applicants argue that Takiguchi et al. (US 5,137,796) does not teach a silica coating which is defined in the present specification as "a silica layer is formed on the

outermost layer of the magnetic carrier covering the outside of the ferromagnetic iron oxide particle”.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., silica layer covering the outermost layer of the magnetic particle) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Since the claims contain opening “comprising language”, they fail to exclude other elements such as a “developing sleeve surface” which covers the silica coated magnetic particles as taught in Takiguchi et al.

Because Takiguchi et al. teach ferromagnetic iron oxide particles and silica powder, as in the instant claims, absent objective evidence to the contrary, silica is adhering to the vicinity of the particles. Certainly the silica of Takiguchi is mixed with and in contact with the particles. Applicant appears to argue that despite this contact the silica does not adhere to the particle, but does not explain why the silica does not so adhere. Applicant's argument that such adhesion does not take place is mere argument of counsel and provides no objective evidence therefor.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pensee T. Do whose telephone number is 571-272-0819. The examiner can normally be reached on Monday-Friday, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Shibuya can be reached on 571-272-0806. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pensee T. Do/
Examiner, Art Unit 1641

/Mark L. Shibuya/
Supervisory Patent Examiner, Art Unit 1641